

REMARKS

I. Disposition Of The Claims

Claims 1-40 and 48-51 are pending. Claims 5-6, 11-40, and 49-51 were withdrawn from consideration. Office action, p. 2. Claims 41-47 were previously canceled. Claims 1-4, 7-10 and 48 stand rejected.

The withdrawn claims 5-6 should be rejoined. MPEP §§ 803.02; 821.04. It is also submitted that no serious burden would prevent examining such claims.

Claims 1, 3-4, and 7 have been amended as shown. Support is in the specification as filed and highlighted below where relevant.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the examined claims in condition for allowance. It is submitted that the proposed amendments of the amended claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, it is respectfully submitted that the entering of the Amendment would allow a reply to the final rejections and would place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

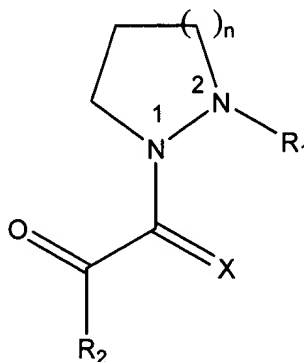
II. Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-4, 7-10, and 48 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Office action, p. 2.

A. The esters

Unspecified claims from claims 1-4, 7-10, and 48 were rejected under 35 U.S.C. § 112, second paragraph, presumably for reciting "ester thereof." Office action, pp. 2-3. It is believed

that the Examiner would agree (1) that the term “ester” has meaning to one of ordinary skill in the art and (2) that one of ordinary skill in the art would be able to determine whether or not a particular compound fell within the ambit of the structural compound of formula I as recited, e.g., in claim 1, i.e.,



Given (1)-(2), it seems reasonable to conclude that one of ordinary skill in the art would have been reasonably apprised of which compounds were an “ester thereof” as recited, e.g., in claim 1.

Because the meaning of “ester thereof” and thus each claim is discernible, each claim avoids a rejection on indefiniteness grounds. Accordingly, this rejection should be withdrawn.

B. “carbocycle,” “heteroaryl,” and “heterocycle”

Unspecified claims from claims 1-4, 7-10, and 48 were rejected under 35 U.S.C. § 112, second paragraph, for reciting “carbocycle,” “heteroaryl,” and “heterocycle.” Office action, pp. 2-3. The present version of the claims avoids these rejections.

Specifically, the following language was added at the end of claims 1, 4, and 7:

, wherein the heteroaryl, carbocycle, and heterocycle are selected from cyclopentyl, cyclohexyl, cycloheptyl, phenyl, benzyl, naphthyl, indenyl, azulenyl, fluorenyl, anthracenyl, indolyl, isoindolyl, indoliny, benzofuranyl, benzothiophenyl, indazolyl, benzimidazolyl, benzthiazolyl, tetrahydrofuranyl, tetrahydropyranyl, pyridyl, pyrrolyl, pyrrolidinyl, pyridinyl, pyrimidinyl, purinyl, quinolinyl, isoquinolinyl, tetrahydroquinolinyl, quinoliziny, furyl, thiophenyl, imidazolyl,

oxazolyl, benzoxazolyl, thiazolyl, isoxazolyl, isotriazolyl, oxadiazolyl, triazolyl, thiadiazolyl, pyridazinyl, pyrimidinyl, pyrazinyl, triazinyl, trithianyl, indolizinyl, pyrazolyl, pyrazolinyl, pyrazolidinyl, thienyl, tetrahydroisoquinolyl, cinnolyl, phthalazinyl, quinazolinyl, quinoxalinyl, naphthyridinyl, pteridinyl, carbazolyl, acridinyl, phenazinyl, phenothiazinyl, phenoxazinyl, adamantly, pyrrole groups, thiophene groups, pyridine groups, and isoxazole groups[.]

Support for the present amendment is in the specification as filed, e.g., page 34, lines 12-13 and page 35, lines 14-29. No new matter has been added. Grouping heteroaryl, carbocycle, and heterocycle in one paragraph saved space. It is submitted that one of ordinary skill in the art would be able to determine the members belonging to each grouping.

Because the present version of the claims avoids these rejections, these rejections should be withdrawn.

C. “thiocarbonyl” and “carbonyl”

Unspecified claims from claims 1-4, 7-10 and 48 were rejected under 35 U.S.C. § 112, second paragraph, for reciting “thiocarbonyl” and “carbonyl.” Office action, pp. 2-3. This language has been deleted from each of claims 1, 4, and 7. Thus, the present version of the claims avoids this rejection, which should be withdrawn.

D. “affecting a neuronal activity”

Claims 7-10 were rejected under 35 U.S.C. § 112, second paragraph, for reciting “affecting a neuronal activity.” Office action, pages 2-3. The rejection’s reasoning stated that the term “‘affecting’ can have many meanings” and is therefore indefinite. Office action, p. 3. It is respectfully submitted that the reasoning cuts against the position taken in the rejection.

A claim is sufficiently definite to satisfy the statutory requirement of section 112 paragraph 2 if one of ordinary skill in the art would understand the bounds of the claim when read in light of the specification. Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993). Most importantly here, a claim is definite if it is amenable

to construction, however confusing that task may be. Exxon, 265 F.3d at 1375, 60 USPQ2d at 1276.

In this rejection, the cited term is amenable to claim construction, since the meaning of “affecting” is available from dictionaries. For example, one Oxford Dictionary reads “v. have an effect on; make a difference to.” Concise Oxford English Dictionary, 10th Ed., p. 22 (enclosed for consideration). It is submitted that this term, when read in light of the specification, would have been clear to one of ordinary skill in the art. Since the meaning of each rejected claim is discernible, each rejected claim avoids a rejection on indefiniteness grounds. Thus, the rejection should be withdrawn.

III. Rejections Under 35 USC § 112, First Paragraph

A. Claims 1-4, 7-10 and 48

Claims 1-4, 7-10, and 48 were rejected under 35 U.S.C. § 112, first paragraph, because the specification does not reasonably provide enablement for “solvates” of the compound of formula I. Office action, pp. 4-5. The present version of the claims avoids this rejection, because claims 1, 3-4, and 7 were amended to delete the term “solvate.” Thus, the rejection should be withdrawn.

B. Claims 7-10

Claims 7-10 were rejected under 35 U.S.C. § 112, first paragraph, because the specification does not reasonably provide enablement for affecting a neuronal activity, preventing neurodegeneration, treatment of a neurological disorder, and preventing or treating Alzheimer’s disease, Huntington’s disease or ALS. Office action of 10-07-2004, page 3. The reasoning is on pages 3-6 of the non-final Office action of 10-07-2004. The reasoning is summarily reiterated and/or supplemented in the present Office action (pp. 5-6).

The rejection stated that “it is not even clear what ‘affecting’ means.” Office action, p. 5. It is submitted that the Examiner will not maintain this position after considering the response to

the § 112, 2d paragraph rejection in the previous section. Thus, this is not a basis in support of the present rejection.

In addition, the rejection noted the lack of a “correlation” between the claimed compounds and the biological activity. Office action, p. 6. It is submitted that the Examiner will not maintain this position after considering the present specification, e.g., at page 27, lines 30-31. The cited language is support for the amendment to claim 7, which reads: the amount is effective to stimulate growth of at least one damaged peripheral nerve of the mammal or to promote at least one neuronal regeneration in the mammal. It is submitted that other disclosures support the same amendment. Thus, this is not a basis in support of the present rejection.

Because the reasons for the present rejection are not true, it is requested that the present rejection should be withdrawn.

IV. Non-Statutory Double Patenting Rejections

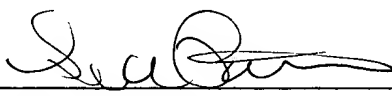
Claims 1-4, 7-10 and 48 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,417,189 (US ‘189). Office action, p. 6. The position is on page 7 of the Office action of 10-07-2004. The present terminal disclaimer avoids this issue. Thus, the present rejection should be withdrawn.

V. Conclusion

It is submitted that the present application is now in condition for allowance. Favorable reconsideration and reexamination of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned attorney by telephone, if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 CFR § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Enclosure: Concise Oxford English Dictionary, 10th Ed., p. 22.

affaire /a'fɛr/, French /afɛr/ (also **affaire de** or **du cœur** /dø'kœ, dju:/, French /da, dy'kœr/) ● n. a love affair.
- ORIGIN C19: Fr., lit. 'affair (of the heart)'.
- ORIGIN C19: from *affaire*, from *a-* 'to' + *faire* 'do'.

affairé /a'fɛrɛ/, French /afɛrɛ/ ● adj. busy; involved.
- ORIGIN Fr., from *affaire*, from *a-* 'to' + *faire* 'do'.
affect /ə'fɛkt/ ● v. have an effect on; make a difference to. > touch the feelings of.
- DERIVATIVES **affecting** adj. **affectingly** adv.
- ORIGIN ME: (in the sense 'attack as a disease'): from Fr. *affecter* or L. *affect*; *afficere* (see **AFFECT**).

USAGE **affect**

Affect and **effect** are commonly confused. **Affect** is primarily a verb meaning 'make a difference to'. **Effect** is used both as a noun and a verb, meaning 'a result' or 'bring about (a result)'.
affect /ə'fɛkt/ ● v. pretend to have or feel. > use, wear, or assume pretentiously or so as to impress.
- ORIGIN ME: (in the sense 'like, love'): from Fr. *affecter* or L. *affectare* 'aim at', frequentative of *afficere* 'affect, influence'.
affect /ə'fɛkt/ ● n. Psychology 'emotion' or desire as 'influencing behaviour'.
- DERIVATIVES **affectless** adj. **affectlessness** n.
- ORIGIN C19: from Ger. *Affekt* from L. *affectus* 'disposition', from *afficere* (see **AFFECT**).
affection ● n. behaviour, speech, or writing that is artificial and 'designed to impress'. > a studied display of feeling.
- ORIGIN C16: from L. *affectatio*(n-), from *affectare* (see **AFFECT**).
affected ● adj. 1 artificial, pretentious, and designed to impress. 2 archaic disposed or inclined in a specified way.
- DERIVATIVES **affectedly** adv. **affectedness** n.
affection ● n. 1 a feeling of fondness or liking. 2 archaic the action or process of affecting or being affected. > a disease. > a mental state; an emotion.
- DERIVATIVES **affectional** adj.
- ORIGIN ME: via OFr. from L. *affectio*(n-), from *afficere* (see **AFFECT**).
affectionate ● adj. readily showing affection.
- DERIVATIVES **affectionately** adv.
affective ● adj. chiefly Psychology relating to moods, feelings, and attitudes.
- DERIVATIVES **affectively** adv. **affectivity** n.
- ORIGIN ME: via Fr. from late L. *affectivus*, from *afficere* (see **AFFECT**).
affenpinscher /'afən,pɪnʃə/ ● n. a dog of a small breed resembling the griffon.
- ORIGIN C20: from Ger., from *Affe* 'monkey' + *Pinscher* 'terrier'.
afferent /'af(ə)nt/ Physiology ● adj. relating to or denoting the conduction of nerve impulses or blood inwards or towards something. The opposite of **EFFERENT**. ● n. an afferent nerve fibre or vessel.
- ORIGIN C19: from L. *afferent*, *afferre* 'bring towards'.
affiance /ə'faɪəns/ ● v. (be **affianced**) poetic/literary be engaged to marry.
- ORIGIN C15: from OFr. *afiancer*, from *afier* 'promise, entrust', from med. L. *affidare* 'declare on oath'.
affiant /ə'faɪənt/ ● n. US Law a person who makes an affidavit.
- ORIGIN C19: from Fr., pres. part. of *afier*, from med. L. *affidare* (see **AFFIANCE**).
affidavit /'afɪdɪvɪt/ ● n. Law a written statement confirmed by oath or affirmation, for use as evidence in court.
- ORIGIN C16: from med. L., lit. 'he has stated on oath', from *affidare*.
affiliate ● v. /ə'fɪliət/ (usu. **be affiliated to/with**) officially attach or connect to an organization. > (of an organization) admit as a member. ● n. /ə'fɪliət/ an affiliated person or organization.
- DERIVATIVES **affiliation** n. **affiliative** adj.
- ORIGIN C18: from med. L. *affiliat*, *affiliare* 'adopt as a son'.
affiliation order ● n. UK Law, historical an order that the man judged to be the father of an illegitimate child must

help to support it.
affinal /ə'fain(ə)l/ ● adj. Anthropology concerning or having a family relationship by marriage.
- ORIGIN C19: from L. *affinis* (see **AFFINITY**) + **-AL**.
affine /ə'fain/ ● adj. Mathematics allowing for or preserving parallel relationships. ● n. Anthropology a relative by marriage.
- ORIGIN C16 (as n-): from OFr. *afin* or L. *affinis* (see **AFFINITY**).
affined ● adj. archaic related or connected.
- ORIGIN C16: from L. *affinis* (see **AFFINITY**) + **-ED**.
affinity ● n. (pl. **-ies**) 1 a spontaneous or natural liking or sympathy. > a close relationship based on a common origin or structure. > relationship by marriage. 2 chiefly Biochemistry the degree to which a substance tends to combine with another.
- ORIGIN ME: via OFr. from L. *affinitas*, from *affinis* 'related' (lit. 'bordering on').
affinity card ● n. a cheque card or credit card for which the bank donates a portion of the money spent using the card to a specific charity.
affirm ● v. state emphatically or publicly. > Law ratify (a judgement or agreement). > Law make a formal declaration rather than taking an oath.
- DERIVATIVES **affirmation** n. **affirmatory** adj. **affirmer** n.
- ORIGIN ME: (in the sense 'make firm'): via OFr. from L. *affirmare*, from *ad-* 'to' + *firmus* 'strong'.
affirmative ● adj. 1 agreeing with or consenting to a statement or request. > Grammar & Logic stating that a fact is so. Contrasted with **NEGATIVE** and **INTERROGATIVE**. 2 relating to or denoting proposed legislation which must receive an affirmative parliamentary vote before it can come into force. ● n. an affirmative statement or word.
- PHRASES **in the affirmative** so as to accept or agree to a statement or request.
- DERIVATIVES **affirmatively** adv.
- ORIGIN ME: (in the sense 'assertive, positive'): via OFr. from late L. *affirmativus*, from *affirmare* (see **AFFIRM**).
affirmative action ● n. chiefly N. Amer. action favouring those who tend to suffer from discrimination.
affix ● v. /ə'fɪks/ attach or fasten to something else. ● n. /'afɪks/ Grammar an addition to the base form or stem of a word in order to modify its meaning or create a new word.
- DERIVATIVES **affixation** n.
- ORIGIN ME: from OFr. *affixer* or med. L. *affixare*, frequentative of L. *affigere*, from *ad-* 'to' + *figere* 'to fix'.
afflatus /ə'flæts/ ● n. formal a divine creative impulse or inspiration.
- ORIGIN C17: from L., from *afflare*, from *ad-* 'to' + *flare* 'to blow'.
afflict ● v. cause pain or suffering to.
- DERIVATIVES **affliction** n. **afflictive** adj. (archaic).
- ORIGIN ME: from L. *afflicare* 'knock about, harass', *afflict*, *affligere* 'knock down, weaken'.
affluent ● adj. 1 wealthy. 2 archaic (of water) flowing freely or copiously. ● n. archaic a tributary stream.
- DERIVATIVES **affluence** n. **affluently** adv.
- ORIGIN ME: via OFr. from L. *affluent*, *affluere* 'flow towards, flow freely'.
afflux /ə'flʌks/ ● n. archaic a flow of water or air.
- ORIGIN C17: from med. L. *affluxus*, from *affluere* (see **AFFLUENT**).
afford ● v. 1 (can/could **afford**) have sufficient money, time, or means for. > be able to do something without risk of adverse consequences. 2 provide (an opportunity or facility).
- DERIVATIVES **affordability** n. **affordable** adj.
- ORIGIN OE *geforðian* 'promote, perform', later 'manage to do', from *ge-* (prefix implying completeness) + *forðian* 'to further', from **FORTH**.
afforest /ə'fɒrɪst/ ● v. 1 convert (land) into forest for commercial exploitation. 2 Brit. historical bring (woodland under the jurisdiction of forest law for the purpose of hunting).
- DERIVATIVES **afforestation** n.

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